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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/810,671	03/29/2004	Veronika Hochstein	MERCK-2867	1160
23599 7590 07/23/2007 MILLEN, WHITE, ZELANO & BRANIGAN, P.C. 2200 CLARENDON BLVD. SUITE 1400 ARLINGTON, VA 22201			EXAMINER KOSLOW, CAROL M	
			ART UNIT 1755	PAPER NUMBER
			MAIL DATE 07/23/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/810,671	Applicant(s) HOCHSTEIN ET AL.	
	Examiner C. Melissa Koslow	Art Unit 1755	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 June 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 and 20-27 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10 and 20-27 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 20 June 2007 has been entered.

The amendment to claim has overcome the 35 USC 112 rejection. Applicant's arguments with respect to the art rejections have been considered but are moot in view of the new grounds of rejection based on applicants' addition of "a cosmetic active ingredient" to the claims. This limitation was not earlier claimed and thus was not addressed in the earlier rejections.

Claims 1-10 and 20-27 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1-10 and 20-27 are indefinite as to the meaning of "pigment mixture". It is unclear if this phrase has the meaning given in the specification which is that it consists of components A and B; if it has the definition of original claims 7-9 of a composition comprising component A, component B and additional components or if applicants are actually claiming a cosmetic formulation, as implied by claims 24 and 27. The specification teaches the pigment mixture, which consists of components A and B, can be further mixed with other components, but it does not refer to this composition of A, B and additional components as a "pigment mixture". In addition, the specification teaches the forms of claims 24 and 27 are the forms of cosmetic formulas that contain the pigment mixture of A and B (para. 9, 28, 43 and 44).

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The Examiner is interpreting the claims as being directed to cosmetic formulations since this interpretation encompasses the subject matter of largest number of claims. Since original claim 11 to a cosmetic composition was examined, the amended and new claims 1-10 and 20-27 are thus elected by original presentation. The compositions in paragraph [0038] are examples of cosmetic active ingredients and thus the definition of "cosmetic active ingredient" is not limited to those specifically disclosed.

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-4, 7-10, 23-25 and 27 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-8 and 10-19 of U.S. Patent No. 6,517,628 in view of U.S. patent 6,606,071. Although the conflicting claims are not identical, they are not patentably distinct from each other because claim 8 teaches a cosmetic comprising a pigment mixture of a component A which is an effect pigment based on glass flakes and

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component B comprising a platelet-shaped, acicular or spherical colorant. Claims 6, 16 and 17 further define B as a pearlescent pigment, carbon black, and inorganic and organic pigments, which includes those of claim 23 in this application. Claim 11 further defines A as a pigment has the structure of glass flake, ferric oxide layer, silica layer and one of a ferric oxide layer or a titania layer; glass flake, titania layer, silica layer and one of a ferric oxide layer or a titania/ferric oxide layer; glass flake, ferric oxide/titania layer, silica layer and a ferric oxide/titania layer or glass flake, titania layer, silica layer and chromium oxide layer. Claim 7 teaches the ratio of A to B is 10:1 to 1:10 or 9:91 to 91:9, which overlaps the claimed range. The cosmetic is taught in general which means any known cosmetic is claimed and thus include known ones comprising a cosmetic active ingredient and additional known conventional additives, such as those discussed in U.S. patent 6,606,071.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1-10, 20, 21 and 23-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. patent 6,517,628 in combination with U.S. patent 6,060,071.

U.S. patent 6,517,628 suggests lipsticks, shampoos and shower gels, which are also termed bath gels, comprising a pigment mixture and conventional additives for these cosmetics, such as preservatives and oils for lipsticks and surfactants, water and fragrance for shower gels and shampoos. Shampoos and shower gels are surfactant-containing cleansers. The reference teaches the pigment mixtures for these cosmetics comprises a mixture of component A which is a multilayered pigment and component B which are platelet, acicular or spherical shaped colorants and/or fillers. The multilayered pigment of component A possesses one of the following

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structures: substrate+ferric oxide layer+silica layer+ferric oxide layer; substrate+ferric oxide layer+silica layer+titanium layer; substrate+titanium layer+silica layer+ferric oxide layer; substrate+titanium layer+silica layer+ferric oxide/titanium layer; substrate+ferric oxide/titanium layer+silica layer+ferric oxide/titanium layer and substrate+titanium layer+silica layer+chromic oxide layer; where the substrate can be glass flakes having a thickness in the range of 0.4-2 microns, which overlaps the claimed range. Product claims with numerical ranges which overlap prior art ranges were held to have been obvious under 35 USC 103. *In re Wertheim* 191 USPQ 90 (CCPA 1976); *In re Malagari* 182 USPQ 549 (CCPA 1974); *In re Fields* 134 USPQ 242 (CCPA 1962); *In re Nehrenberg* 126 USPQ 383 (CCPA 1960). Pigment B can be pearlescent, multilayered or interference pigments or spherical pigments of titanium, colored silica, calcium sulfate, iron oxides, chromium oxides, carbon black, anthraquinone pigments, quinacridone pigments, diketopyrrolopyrrole pigments, phthalocyanine pigments, azo pigment or isoindoline pigments. The taught weight ratio of components A and B is 10:1 to 1:10, or 9:91 to 91:9, which overlaps the claimed range.

U.S. patent 6,517,628 does not teach cosmetics containing ectoin, which is a pyrimidinecarboxylic acid. U.S. patent 6,060,071 teaches adding ectoin to lipsticks and surfactant-containing cleansers to improve and stabilize the hydration of the human skin. Thus one of ordinary skill in the art would have found it obvious to add ectoin to the lipstick, shampoo and shower gel suggested in U.S. patent 6,517,628 to improve and stabilize the hydration of the human skin, which is desirable in the art for the reasons given in lines 15-30 in U.S. patent 6,060,071. The references suggest the claimed composition.

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Claims 1, 7, 10, 20-22 and 24-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over WO 03/006558 in combination with U.S. patent 6,060,071.

WO 03/6558 teaches, in use example 1, a shimmering foundation, a make-up in the form of an emulsion, comprising water, fragrance, oil, silica, thickeners, stabilizing agents and a mixture of iron oxide coated mica pigments and an effect pigment based on a glass flake, where the weight ratio of iron coated mica pigments to glass flake based effect pigment is 4.7 to 4.5 or 51:59, which falls within the claimed range. The glass flake is coated with a tin oxide layer, a titania layer, a silica layer and a titania layer. Page 11, lines 16-35 teaches the titania layers in the taught pigments are in the rutile or anatase modification.

WO 03/6558 does not teach compositions containing ectoin, which is a pyrimidinecarboxylic acid. U.S. patent 6,060,071 teaches adding ectoin to lipsticks and surfactant-containing cleansers to improve and stabilize the hydration of the human skin. Thus one of ordinary skill in the art would have found it obvious to add ectoin to the foundation taught in WO 03/6558 to improve and stabilize the hydration of the human skin, which is desirable in the art for the reasons given in lines 15-30 in U.S. patent 6,060,071. The references suggest the claimed composition.

Claims 1, 3, 9, 10, 20-22 and 24-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP 2001-11340 in view of U.S. patent 6,060,071.

JP 2001-11340 teaches a powder foundation (example 9) and a blusher (example 10). These examples teach the cosmetics comprising conventional additives, such as silicone oil, preservatives, fragrances, surfactants, and a pigment mixture of mica and an effect pigment based on glass flake. The weight ratio of mica pigment to effect pigment in the blusher is 36:64

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and the weight ratio of mica pigment to effect pigment in the powder foundation is 5:95. These ratios fall within the claimed range. The effect pigment in the cosmetics has the layer structure glass flake and titania layer, where the titania is in the anatase modification.

JP 2001-11340 does not teach compositions containing ectoin, which is a pyrimidinecarboxylic acid. U.S. patent 6,060,071 teaches adding ectoin to lipsticks and surfactant-containing cleansers to improve and stabilize the hydration of the human skin. Thus one of ordinary skill in the art would have found it obvious to add ectoin to the foundation and blusher taught in JP 2001-11340 to improve and stabilize the hydration of the human skin, which is desirable in the art for the reasons given in lines 15-30 in U.S. patent 6,060,071. The references suggest the claimed composition.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Melissa Koslow whose telephone number is (571) 272-1371. The examiner can normally be reached on Monday-Friday from 8:00 AM to 3:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jerry Lorengo, can be reached at (571) 272-1233.

The fax number for all official communications is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

cmk
July 20, 2007


C. Melissa Koslow
Primary Examiner
Tech. Center 1700